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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/705,948	11/13/2003	Michael Walter Hoche	Q78335	6731

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WASHINGTON, DC 20037

EXAMINER
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HARRIER, JASON D

ART UNIT	PAPER NUMBER
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3628

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	04/09/2007	PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

**Office Action Summary**

Application No.

10/705,948

Applicant(s)

HOCHE ET AL.

Examiner

Jason D. Harrier

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 13 November 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-13 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-13 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date 11/13/2003.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_.

## DETAILED ACTION

### *Claim Rejections - 35 USC § 101*

1. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

**Claims 12 and 13** are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

**As per Claims 12 and 13**, Claims to computer-related inventions that are clearly nonstatutory fall into the same general categories as nonstatutory claims in other arts, namely natural phenomena such as magnetism, and abstract ideas or laws of nature which constitute “descriptive material.” Abstract ideas, Warmerdam, 33 F.3d at 1360, 31 USPQ2d at 1759, or the mere manipulation of abstract ideas, Schrader, 22 F.3d at 292-93, 30 USPQ2d at 1457-58, are not patentable. Descriptive material can be characterized as either “functional descriptive material” or “nonfunctional descriptive material.” In this context, “functional descriptive material” consists of data structures and computer programs which impart functionality when employed as a computer component. (The definition of “data structure” is “a physical or logical relationship among data elements, designed to support specific data manipulation functions.” The New IEEE Standard Dictionary of Electrical and Electronics Terms 308 (5th ed. 1993).) “Nonfunctional descriptive material” includes but is not limited to music, literary works and a compilation or mere arrangement of data. Both types of “descriptive material” are nonstatutory when claimed as descriptive material per se. Warmerdam, 33 F.3d at 1360, 31 USPQ2d at 1759. When functional descriptive material is recorded on some computer-readable medium it becomes structurally and functionally interrelated to the medium and will be statutory in most cases since

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use of technology permits the function of the descriptive material to be realized.

The present claims are directed to merely a software program per se. A software program per se is considered nonfunctional descriptive material and thus nonstatutory subject matter.

***Claim Rejections - 35 USC § 102***

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. **Claims 1-13** are rejected under 35 U.S.C. 102(b) as being anticipated by Briscoe (International Publication Number WO 99/65183).

**As per Claim 1**, Briscoe discloses an accounting advisor method for guiding a user of a mobile telecommunication device when intending to invoke a service comprising the steps of:

- providing a service choice and invoking a selected service, (Page 22, lines 10-20) and
- account processing at a subscriber's mobile telecommunication device (Page 4, lines 15-25; Page 12, lines 20-30) ,

wherein the mobile telecommunication device is enabled for processing multiple accounts and advising a user by further comprising the following steps:

- retrieving accounting information (Page 4, lines 15-33),
- analyzing service and tariff constraints based on recorded user behavior and retrieved accounting information (Page 17, lines 20-34; Page 18, lines 1-20), and

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- deriving a recommended service and account selection based on said analyzing with respect to optimization criteria (Page 15, lines 10-20).

**As per Claim 2**, Briscoe further discloses the accounting advisor method according to claim 1 wherein said method comprises a further step of negotiating service and tariff characteristics (Page 2, lines 30-34; Page 3, lines 1-30; Page 7, line 30 – Page 8, line 15; Page 20, lines 5-30; Page 22, lines 10-20) (Examiner interprets the use of information from a user terminal to determine a tariff price, and the user option to accept or reject that price equivalent to the negotiation of service).

**As per Claim 3**, Briscoe further discloses the accounting advisor method according to claim 1, wherein said method comprises a further step of recording user behavior into a user profile. (Page 5, lines 1-10; Page 17, lines 20-30, Page 18, lines 10-15)

**As per Claim 4**, Briscoe disclose a mobile telecommunication device adapted to guide a user when intending to invoke a service, wherein said mobile telecommunication device comprises an advisor unit recording user behavior, (Page 17, lines 20-30, Page 18, lines 10-15), retrieving accounting information, (Page 4, lines 15-33), analyzing service and tariff constraints, (Page 17, lines 20-34; Page 18, lines 1-20), and deriving a recommended service and account selection, (Page 15, lines 10-20), and by comprising a user interface for providing an accounting and service guidance based on said recommended service and account selection when invoking or intending to invoke a service or network logon. (Figure 9; Page 9, lines 10-26; Page 10, lines 10-25; Page 22, lines 1-25)

**As per Claim 5**, Briscoe further discloses the mobile telecommunication device according to claim 4, wherein the mobile telecommunication device is embedded within a

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notebook, a personal digital assistant (PDA), a personal computer, or a car-telematic system.

(Page 5, lines 25-32; Page 22, lines 25-34; Page 23, lines 1-10) (Discloses a “smart telephone” containing a microprocessor and data interface. Examiner interprets a “smart telephone” including a microprocessor to be a PDA or personal computer)

**As per Claim 6**, Briscoe further discloses the mobile telecommunication device according to claim 4, wherein said user interface comprises a user interface for invoking a service or network logon with an accounting and service guidance when invoking a service by raising a menu with at least one recommended selection. (Figure 9; Page 9, lines 10-26; Page 10, lines 10-25; Page 22, lines 1-25)

**As per Claim 7**, Briscoe further discloses the mobile telecommunication device according to claim 4, wherein said user interface comprises elements for additionally providing information on which a recommended selection is based. (Figure 9; Page 9, lines 10-26; Page 10, lines 10-25; Page 22, lines 1-25)

**As per Claim 8**, Briscoe further discloses the mobile telecommunication device according to claim 4, wherein said user interface comprises elements for additionally providing information about consequences of a selection. (Figure 9; Page 9, lines 10-26; Page 10, lines 10-25; Page 22, lines 1-25)

**As per Claim 9**, Briscoe further discloses the mobile telecommunication device according to claim 4, wherein said user interface comprises elements for providing application-context related information, known from former usage by the identified user. (Figure 9; Page 9, lines 10-26; Page 10, lines 10-25; Page 22, lines 1-25)

**As per Claim 10**, Briscoe discloses a base station in a mobile telecommunication infrastructure adapted to enable a mobile telecommunication device guiding a user when intending to invoke a service, wherein said base station and said mobile telecommunication device comprise accounting means that are enabled for exchanging accounting information based on accounting inquiries. (Figure 4a; Page 2, lines 30-34; Page 3, lines 1-30; Page 7, line 30 – Page 8, line 15; Page 20, lines 5-30; Page 22, lines 10-20) (Examiner interprets the use of information from a user terminal to determine a tariff price, and the user option to accept or reject that price equivalent to the negotiation of service. Further, Examiner interprets the use of a network management platform and a host network to include a base station).

**As per Claim 11**, Briscoe further discloses the base station according to claim 10, wherein said accounting means are enabled for trading and answering on negotiation requests with service or tariff characteristics. (Page 2, lines 30-34; Page 3, lines 1-30; Page 7, line 30 – Page 8, line 15; Page 20, lines 5-30; Page 22, lines 10-20) (Examiner interprets the use of information from a user terminal to determine a tariff price, and the user option to accept or reject that price equivalent to the negotiation of service).

**As per Claim 12**, Briscoe discloses a computer software product for guiding a user of a mobile telecommunication device when intending to invoke a service, wherein recording user behavior, retrieving and processing accounting information, analyzing and evolving service or tariff constraints, and deriving a recommended account selection based on optimization criteria or strategies. (Tables 1-7; Page 4, lines 15-33; Page 7, line 30 – Page 8, line 15; Page 9, lines 10-32; Page 22, lines 5-25).

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**As per Claim 13**, Briscoe further discloses the computer software product according to claim 12, wherein said computer software product has downloadable enhancements. (Page 10, lines 15-30 Page 21, line 33 – Page 22, line 2).

### ***Conclusion***

**Examiner's Note:** Examiner has cited particular columns, line numbers, and paragraphs in the references as applied to the claims above for the convenience of the applicant. Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested that the applicant, in preparing responses, fully consider each of the references in its entirety as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art disclosed by the examiner.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jason D. Harrier whose telephone number is (571) 272-5866. The examiner can normally be reached on Monday - Friday 9:00am - 5:30pm EST..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John W. Hayes can be reached on (571) 272-6708. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Jason D. Harrier  
Art Unit 3628

JDH

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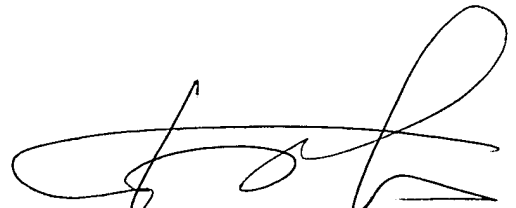
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Or fax to:

**(571) 273-5866** [Informal/Draft communications, labeled "PROPOSED" or "DRAFT"]

Hand delivered responses should be brought to the Customer Service Window, Randolph Building, 401 Dulany Street, Alexandria, VA 22314.



IGOR N. BORISSOV  
PRIMARY EXAMINER